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HAMILTON & TERRILE, LLP			ROSEN, NICHOLAS D	
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3625

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/770,694	<b>Applicant(s)</b> CONNORS ET AL.	
	<b>Examiner</b> Nicholas D. Rosen	<b>Art Unit</b> 3625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13,15-35,37,39-43,45-48,51-62 and 64-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13,15-35,37,39-43,45-48,51-62 and 64-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/3/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-13, 15-35, 37, 39-43, 45-48, 51-62, and 64-74 have been examined.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 11, 2006 (and certified as being mailed on January 6, 2006) has been entered.

### ***Claim Objections***

Claim 10 is objected to because of the following informalities: In the second and third lines of claim 10, "that is allowable product configurations" should be "that is an allowable product configuration". Appropriate correction is required.

Claim 33 is objected to because of the following informalities: In the second and third lines of claim 33, "that is allowable product configurations" should be "that is an allowable product configuration". Appropriate correction is required.

Claim 48 is objected to because of the following informalities: In the third and fourth lines of claim 48, "that is allowable product configurations" should be "that is an allowable product configuration". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-13, 15-23, and 73**

Claims 1, 4, 5, 6, 13, 15, 16, 17, 18, 19, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) in view of official notice. As per claim 1, Smith discloses a computer system to provide one or more product selections to a user in accordance with an analysis of user needs, the computer system comprising: a database to storing product configuration information, wherein the product configuration information comprises product attribute information (column 7, lines 8-21) and pre-generated product configurations (column 8, lines 43-62); and a processor (column 7, lines 1-7). Smith does not expressly disclose a memory to which

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the processor is coupled, but not only would the database require a memory, but Smith's disclosure of one or more computer programs running on a suitable computer processor or processors (column 7, lines 1-7) inherently requires a memory coupled to the processor wherein the one or more computer programs are stored. Smith further discloses receiving product related data from the user through a communication link coupled between a data processing system of the user and a data receiving module, wherein the product related data is a member of a group of information types comprising attribute information and product identifier information (column 7, line 63, through column 8, line 62); a filter service module to process received product attribute information in accordance with the product configuration information stored in the database in order to identify one or more of the pre-generated product configurations stored in the database that meet requirements of the received product attribute information (column 10, lines 14-27); a configuration service module to process received product identifier information to identify one or more of the pre-generated product configurations stored in the database and identify one or more product configurations that meet requirements of the received attribute information (column 10, lines 14-27); and a presentation module to provide each identified pre-generated product configuration to the user via the communication link (column 10, lines 14-27; Figure 5). Smith does not expressly disclose a needs analysis module to process the received product related data, but some form of data processing would be inherent to enable the system to use the received product related data to search inventory, etc. Smith does not disclose that the needs analysis module determines which type of

information is included in the received product related data, but official notice is taken that it is well known to determine which kind of information is included in data. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have a needs analysis module determine which type of information is included in the received product related data, for the obvious advantage of deciding what action to take in response to the product related data.

Smith does not disclose that the various modules are stored in the memory, but given a program of programs running on suitable computer processors, as disclosed, the sections of programming which cause Smith's system to carry out its functions can be viewed as modules stored in memory.

As per claim 4, Smith does not expressly disclose that the filter service module is configured to provide a product identifier to said needs analysis module in response to attribute information received from said needs analysis module, but discloses that a product is identified in response to a product attribute or attributes, and also that the product identifier identifies an existing (pre-generated) product, and the attribute information is an attribute of the product (column 8, lines 24-62; column 10, lines 14-27). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the filter service to be appropriately configured, in order to carry out the disclosed functions of Smith's invention.

As per claim 5, Smith discloses that the filter service is configured to use said attribute information to retrieve the product identifier from the database (column 8, lines 24-62; column 10, lines 14-27).

As per claim 6, Smith discloses that the database contains product identifier information that identifies each pre-generated product configuration and reference data that links the product attribute information to a pre-generated product configuration (column 8, lines 24-62; column 10, lines 14-27).

As per claim 13, Smith discloses permitting identification of at least one pre-generated product configuration based on product identifier information (column 8, lines 24-62; column 10, lines 14-27).

As per claim 15, Smith does not expressly disclose that the configuration service module is configured to provide a configuration list to the needs analysis module in response to a product identifier received from the needs analysis module, but one can define whatever software module is involved in providing lists of the attributes of the various products in Smith's system as a configuration service, and Smith does disclose comparing product identifiers identifying products with configuration/attribute data for products, to determine which products match listed attributes (column 8, lines 24-62; column 10, lines 14-27).

As per claim 16, Smith does not expressly disclose that said configuration list is a list of the available features of said product, but such a list of available features would have been obvious for the purpose of enabling Smith's system to carry out its function of determining which, if any, available products match user-desired attributes (column 8, lines 24-62; column 10, lines 14-27).

As per claim 17, Smith does not expressly disclose that said configuration list is a list of the configurations of said product, but such a list of configurations would have

been obvious for the purpose of enabling Smith's system to carry out its function of determining which, if any, available products match user-desired attributes (column 8, lines 24-62; column 10, lines 14-27).

As per claim 18, Smith does not expressly disclose that the configuration service is configured to use the product identifier to generate the configuration list from information stored in the database, but given that configuration/attribute information for products stored in the database are compared to attributes to determine which products match listed attributes (column 8, lines 24-62; column 10, lines 14-27), generating such configuration lists is held to be obvious, to make the system able to carry out its functions.

As per claim 19, Smith discloses that the database contains product identifier information (column 8, lines 24-62; column 10, lines 14-27).

As per claim 73, Smith discloses that the product related data includes data related to a vehicle (e.g., column 8, lines 24-42).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and official notice as applied to claim 1 above, and further in view of Neuborne et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle Those Wares Online?"). Smith does not disclose a software configuration engine stored in the memory to generate the pre-generated product configurations, but Neuborne teaches modifying product configurations by choosing options (paragraph beginning, "The program lets MasterCard slap its logo") which implies generating the basic configurations, and perhaps the configurations as modified



by options, if there are a limited number of options, leading to choices of vehicles configured in advance. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the computer system include a software configuration engine to generate the pre-generated product configurations, for the obvious advantage of being able to present configurations and options to a user.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and official notice as applied to claim 1 above, and further in view of Neuborne et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle Those Wares Online?"). Smith does not disclose that the data receiving module is further configured to receive data indicating a user selected product, wherein the selected product corresponds to one of the identified product configurations, and the data receiving module is further configured to receive product configuration selections from the user to further configure the selected product, but Neuborne teaches receiving product configuration selections from a user to further configure a selected product, and generating configured product data as selected (paragraph beginning, "The program lets MasterCard slap its logo"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the data receiving module thus configured, for the obvious advantage of enabling the user to configure the selected product according to his own wishes.

Neuborne does not expressly teach that the presentation module is further configured to present the configured product data to the user via the communication link, but does teach an interactive design shop and an online order form; official notice is taken that it is well known to present descriptions of what is being purchased on online order forms. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to present the configured product data to the user via the communication link, for the obvious advantage of enabling the user to assure himself of what he had ordered.

Claims 7, 8, 9, 10, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and official notice as applied to claim 6 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 7, Smith does not disclose that the database comprises a configuration table storing the pre-generated product configurations, and an attribute table storing the product attribute information, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise tables, specifically a configuration table and an attribute table, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 8, Smith does not expressly disclose that the configuration table contains product identifier information, but the use of tables being obvious (as set forth above, regarding claim 7), storing this particular kind of information in the configuration

table would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention.

As per claim 9, Smith does not disclose that the tables comprise records comprising fields which contain corresponding information (attribute information in an attribute field, etc.), but the Microsoft Press Computer Dictionary teaches the use of fields in databases (definition of field, sense 1, page 194). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the tables comprise records comprising fields which contain corresponding information, for the obvious advantage of enabling data to be stored using standard techniques for easy storage and access.

As per claim 10, Smith discloses that said configuration information describes a configuration of a product; said attribute information describes an attribute of a product; and said configuration of said product includes said attribute of said product (column 8, lines 24-62), and for the product to actually exist in inventory, etc., its configuration must be allowable.

As per claim 11, Smith discloses that the needs analysis module is configured to access the configuration information through the filter service module (column 8, lines 24-62; column 10, lines 14-27).

As per claim 12, Smith discloses by inherency that a reference to a configuration record allows the filter service to access the configuration record according to attribute information, and therefore to access attribute records using attribute information (column 8, lines 24-42; column 10, lines 14-27).

Claims 20, 21, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and official notice as applied to claim 19 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 20, Smith does not disclose that the database comprises a configuration table containing said product identifier information and said configuration information, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise a configuration table, specifically containing identifier information and configuration information, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 21, Smith discloses that the needs analysis module is configured to access the configuration information, and that the configuration service module is configured to access the database (column 8, lines 24-42; column 10, lines 14-27). Smith does not expressly disclose that the needs analysis module supplies product identifier information to the configuration service (as well as to the user of the system), or that the configuration service module uses product identifier information to access the database. However, this is a mere verbal reshuffling. One can describe whatever module of Smith's system is involved in receiving the product identifier information (e.g., to be passed to the user) as a configuration service, and whatever module uses a product identifier to access the database (e.g., in comparing identified products to desired attributes) as a configuration service.

As per claim 22, Smith does not disclose that the configuration table comprises a configuration record comprising pre-generated product configurations and identifier fields which contain corresponding information, but the Microsoft Press Computer Dictionary teaches the use of fields in databases (definition of field, sense 1, page 194). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the configuration table comprise records comprising fields which contain corresponding information, for the obvious advantage of enabling data to be stored using standard techniques for easy storage and access.

As per claim 23, Smith discloses that said configuration information describes a configuration of the product, and product identifier information identifies the configuration of the product (column 8, lines 24-42; column 10, lines 14-27). Smith further discloses can configure and save product configurations (column 10, lines 28-48).

**Claims 24-35, 37, 39-48, and 74**

Claims 24, 25, 26, 27, 28, 29, 37, 39, 40, 41, 42, 43, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) in view of official notice. Claims 24, 26, 27, 28, 29, 37, 40, 41, 42, 43, and 74 are essentially parallel to claims 1, 3, 4, 5, 6, 13, 15, 16, 17, 18 and 73, respectively, and rejected on essentially the same grounds.

As per claim 25, Smith discloses a computer permitting identification of a product based on attribute information, implying code for doing so (column 8, lines 24-42; column 10, lines 14-48).

As per claim 39, Smith does not expressly disclose a needs analysis module to process the received product related data, but some form of data processing would be inherent to enable the system to use the received product related data to search inventory, etc. Smith does not disclose that the needs analysis module determines which type of information is included in the received product related data, but official notice is taken that it is well known to determine which kind of information is included in data. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have a needs analysis module determine which type of information is included in the received product related data, for the obvious advantage of deciding what action to take in response to the product related data. Even this is unnecessary if one does not read a description of what a needs analysis module does from claim 1 into claim 39. Smith discloses a computer system analyzing needs (column 8, lines 24-42; column 10, lines 14-27), which implies that the code comprises a needs analysis module.

Claims 30, 31, 32, 33, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and official notice as applied to claim 29 above, and further in view of the Microsoft Press Computer Dictionary. Claims 30, 31, 32, 33, and 35 are essentially parallel to claims 7, 8, 9, 10, and 12, respectively, and rejected on essentially the same grounds. As per claim 34, Smith discloses accessing pre-generated product

configuration identifier information using said attribute information (column 8, lines 24-42; column 10, lines 14-27).

Claims 45, 46, 47, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and official notice as applied to claim 24 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 45, Smith discloses that the data structure contains product identifier information (column 8, lines 24-62; column 10, lines 14-27). Smith does not disclose that the data structure comprises a configuration table containing said product identifier information, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise a configuration table, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 46, Smith discloses accessing the configuration information, and accessing the database (column, 24-42; column 10, lines 14-27). Smith does not expressly disclose the code by supplying the product identifier information to a configuration server, and using the product identifier information to access the database, but this is held to be mere verbal reshuffling. One can describe whatever module of Smith's system is involved in receiving the product identifier information (e.g., to be passed to the user) as a configuration service, and whatever module uses a product identifier to access the database (e.g., in comparing identified products to desired attributes) as a configuration service.

As per claim 47, claim 47 is essentially parallel to claim 22, and rejected on essentially the same grounds.

As per claim 48, Smith discloses that the configuration information describes a configuration of the product, and product identifier information identifies a pre-generated configuration of the product (column 8, lines 24-42; column 10, lines 14-27). For product configurations to be stored as packages (column 8, lines 40-42), and still more to actually exist in inventory (column 8, lines 44-62), the product configurations may be presumed to be allowable in accordance with applicable product rules governing allowable combinations of product attributes.

#### **Claims 51-62 and 64-69**

Claims 51, 52, 53, 57, 58, 59, 64, 65, 66, 67, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) in view of official notice. As per claim 51, Smith discloses a method to provide one or more product selections to a user in accordance with an analysis of user needs, the method comprising: receiving product related data from the user through a communication link coupled between a data processing system of the user and a computer system, wherein the product related data is a member of a group of information types comprising attribute information and product identifier information (column 7, lines 8-21; column 7, line 63, through column 8, line 62); processing the received product related data using resources of the computer system (column 7, lines 1-7; column 8, lines 24-62); processing, if the product related data is attribute information, the received product information data in accordance with the product configuration information in order to



identify one or more pre-generated product configurations stored in a database that meet requirements of the received attribute information (column 8, lines 24-62; column 10, lines 14-27); identifying one or more of the pre-generated product configurations that corresponds to the received product related data, if the product related data is product identifier information (column 8, lines 24-62; column 10, lines 14-27); and providing each identified pre-generated product configuration to the user via the communication link (column 8, lines 43-62; column 10, lines 14-27). Smith does not disclose determining which type of information is included in the received product related data, but official notice is taken that it is well known to determine which kind of information is included in data. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to determine which type of information was included in the received product related data, for the obvious advantage of deciding what action to take in response to the product related data.

As per claim 52, Smith discloses that the product identifier information identifies pre-generated product configurations, and the pre-generated product configuration represents a product having an attribute represented in the attribute information (column 8, lines 24-62).

As per claim 53, Smith does not expressly disclose causing a needs analysis module to provide said attribute to said filter service, and causing said filter service to return said product identifier to said needs analysis module, but this essentially follows from regarding the filter service as having a distinct needs analysis module, which

amounts to designating certain circuits, or certain lines of computer code as a “needs analysis module.” This need involve no substantive difference from Smith, and is therefore held to be obvious. (To make separable is considered to be within the level of ordinary skill in the art, *Nerwin v. Erlichman*, 168 USPQ 177, 179 [Board of Patent Appeals and Interferences, 1969]; *In re Dulberg*, 129 USPQ 348, 349; 289 F.2d. 522 [CCPA 1961].)

As per claim 57, Smith discloses providing the product identifier information to a configuration service; identifying the pre-generated product configuration corresponding to the product identifier information by causing the configuration service to query a database using the product identifier information; and causing the configuration service to return the identified pre-generated product configuration (column 8, lines 24-62; column 10, lines 14-36).

As per claim 58, the product identifier information is associated with a pre-generated product configuration in the database (column 8, lines 24-62; column 10, lines 14-36).

As per claim 59, claim 59 is rejected as obvious on essentially the same basis as claim 53. Smith does not expressly disclose causing a needs analysis module to provide said product identifier information to said filter service, and causing said filter service to return said pre-generated product configuration to said needs analysis module, but this essentially follows from regarding the filter service as having a distinct needs analysis module, which amounts to designating certain circuits, or certain lines of computer code as a “needs analysis module.” This need involve no substantive

difference from Smith, and is therefore held to be obvious. (To make separable is considered to be within the level of ordinary skill in the art, *Nerwin v. Erlichman*, 168 USPQ 177, 179 [Board of Patent Appeals and Interferences, 1969]; *In re Dulberg*, 129 USPQ 348, 349; 289 F.2d. 522 [CCPA 1961].)

As per claim 64, Smith discloses that the product related data includes data related to a vehicle (e.g., column 8, lines 24-42).

As per claim 65, Smith discloses that the product configuration selections comprise a make of said vehicle (e.g., column 8, lines 24-42).

As per claim 66, Smith discloses that the product configuration selections comprise a model of said vehicle (e.g., column 8, lines 24-42).

As per claim 67, Smith discloses that the product configuration selections comprise a trim level of said vehicle (e.g., column 8, lines 24-42).

As per claim 68, Smith discloses that the product configuration selections comprise an equipment level of said vehicle (e.g., column 8, lines 24-42).

As per claim 69, Smith discloses that the product configuration selections comprise one of a price range, a vehicle type, an engine type, a fuel economy, an interior feature, and a safety feature (e.g., column 8, lines 24-42).

Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and official notice as applied to claim 51 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 54, Smith discloses querying a database of the computer system (column 8, lines 24-42); identifying at least one product identifier information in a database record comprising the product identifier and

attribute identification; and identifying a pre-generated product configuration associated with attribute information (column 8, lines 24-62). Smith does not disclose accessing an attribute table of said database using said attribute information; accessing said product identifier information in a configuration table of said database to, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise an attribute table and a configuration table, and access those tables, and the data therein, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 55, Smith discloses that the product identifier information is associated with the pre-generated product configuration, and each pre-generated product configuration represents a product having said attribute (column 8, lines 24-62).

As per claim 56, claim 56 is rejected on the same basis as claim 54.

Claims 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and official notice as applied to claim 57 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 60, Smith does not disclose accessing a configuration table of said database using product identifier information to identify said pre-generated product configuration, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise

a configuration table, and access that tables, and the data therein, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 61, Smith discloses that a pre-generated product configuration is associated with product identifier information (column 8, lines 24-62; column 10, lines 14-36).

Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and official notice as applied to claim 51 above, and further in view of Neuborne et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle Those Wares Online?"). Smith discloses receiving data indicating a user selected product, wherein the selected product corresponds to one of the identified pre-generated product configurations (column 8, lines 40-62). Smith does not disclose receiving product configuration selections from the user to further configure the selected product, but Neuborne teaches receiving product configuration selections from a user to further configure a selected product, and generating configured product data as selected (paragraph beginning, "The program lets MasterCard slap its logo"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive such selections, for the obvious advantage of enabling the user to configure the selected product according to his own wishes.

Neuborne does not expressly teach generating configured product data corresponding to the product configuration selections configured product data to the user via the communication link, but does teach an interactive design shop and an online order form; official notice is taken that it is well known to present descriptions of

what is being purchased on online order forms. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate such configured product data, and present the configured product data to the user via the communication link, for the obvious advantage of enabling the user to assure himself of what he had ordered.

### **Claims 70-72**

Claims 70 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) in view of official notice. As per claim 70, Smith discloses an apparatus to provide one or more product selections to a user in accordance with an analysis of user needs, the apparatus comprising: means for receiving product related data from the user through a communication link coupled between a data processing system of the user and a computer system, wherein the product related data is a member of a group of information types comprising attribute information and product identifier information (column 7, lines 8-21; column 7, line 63, through column 8, line 62); means for processing the received product related data using resources of the computer system (column 7, lines 1-7; column 8, lines 24-62); means for processing, if the product related data is attribute information, the received product information data in accordance with the product configuration information in order to identify one or more pre-generated product configurations stored in a database that meet requirements of the received attribute information (column 8, lines 24-62; column 10, lines 14-27); means for identifying one or more of the pre-generated product configurations that corresponds to the received product related data, if the product

related data is product identifier information (column 8, lines 24-62; column 10, lines 14-27); and means for providing each identified pre-generated product configuration to the user via the communication link (column 8, lines 43-62; column 10, lines 14-27). Smith does not disclose means for determining which type of information is included in the received product related data, but official notice is taken that it is well known to determine which kind of information is included in data. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means for determining which type of information was included in the received product related data, for the obvious advantage of deciding what action to take in response to the product related data.

As per claim 72, Smith discloses that the product related data includes data related to a vehicle (e.g., column 8, lines 24-42).

Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and official notice as applied to claim 70 above, and further in view of Neuborne et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle Those Wares Online?"). Smith discloses receiving data indicating a user selected product, wherein the selected product corresponds to one of the identified pre-selected product configurations (column 8, lines 40-62). Smith does not disclose receiving product configuration selections from the user to further configure the selected product, but Neuborne teaches receiving product configuration selections from a user to further configure a selected product, and generating configured product data as selected (paragraph beginning, "The program lets MasterCard slap its logo"). Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the apparatus comprise means for receiving such selections, for the obvious advantage of enabling the user to configure the selected product according to his own wishes.

Neuborne does not expressly teach generating configured product data corresponding to the product configuration selections configured product data to the user via the communication link, but does teach an interactive design shop and an online order form; official notice is taken that it is well known to present descriptions of what is being purchased on online order forms. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the apparatus comprise means for generating such configured product data, and presenting the configured product data to the user via the communication link, for the obvious advantage of enabling the user to assure himself of what he had ordered.

It is noted that claims 70-72 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.



### ***Response to Arguments***

Applicant's arguments filed January 11, 2006, have been fully considered but they are not persuasive. The objection to the drawings has been withdrawn, as have the previous objections to the claims (although some new objections have been made, based on amendments), and the rejection of claim 2 under 35 U.S.C. 112. The claims remain rejected under 35 U.S.C. 103, however. Applicant's arguments against the rejections under 103 all depend on one basic point, that Smith, the primary reference relied upon, does not teach a separate and distinct "filter service module" and "configuration service module". Examiner replies that while the same sections of the Smith patent are, as Applicant argues, relied upon to teach both modules, this is not sufficient to make Applicant's claimed invention distinct and non-obvious. First, claim 1 does not expressly recite any requirement that the filter service module and configuration service module be separate and distinct, so the same module in a prior art system can be used to anticipate or render obvious both. (Similarly, claim 51, for example, does not require that the processing and identifying steps be entirely distinct.) Secondly, even if the independent claims were amended, or narrowly interpreted, to require two distinct modules, the elements would still be considered obvious. As noted above in the rejections of claims 53 and 59, to make known parts separable has been held to be within the level of ordinary skill in the art. Thirdly, if the primary reference does not disclose both of two elements of a claim, the claim can properly be rejected as obvious if another reference teaches the missing element (given motivation to combine, etc.). Thus, there is surely at least as strong a case to find a claim obvious if both of the

elements are disclosed and suggested by a single prior art reference, even if they are not distinguished in quite the way claimed by the applicant.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Guheen et al. (U.S. Patent 6,957,186) disclose a system, method, and article of manufacture for building, managing, and supporting various components of a system. Barck et al. (U.S. Patent 7,003,548) disclose a method and apparatus for developing and checking technical configurations of a product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, another primary examiner in the art unit, Jeffrey A. Smith, can be reached at 571-272-6763. (The examiner's supervisor has just been promoted to director of the work group, and the examiner does not yet know who will be the new supervisor of the art unit.) The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*

**NICHOLAS D. ROSEN  
PRIMARY EXAMINER**

March 3, 2006